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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,465	04/19/2004	Terry L. Turner	0275S-510COB	2992

27572 7590 06/16/2005

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EXAMINER
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CHUKWURAH, NATHANIEL C

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/827,465	TURNER ET AL.	
	Examiner	Art Unit	
	Nathaniel C. Chukwurah	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 23-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/19/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Applicant is respectfully requested to update the Priority/Continuation data in the specification to include US Patent No. 6,729,413.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 recites the limitation "said end wall" on line 2. There is insufficient antecedent basis for this limitation in the claim.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent No. 6,729,413.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ merely in the scope of the subject matter claimed; i.e. claim 23 of the present application are substantially included in claims 1 of US Patent No. 6,729,413,

Art Unit: 3721

but omit the features non-critical to patentability, for example, a receiving member adjacent said cavity.

Further, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are made broader than the specifics of the claims of the Patent as set forth above.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the receiving member adjacent the cavity since the specification discloses such feature.

Claim 24 is rejected under the double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,729,413 because the invention of both claims are the same.

Claim 25 is rejected under the double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,729,413 because the inventions of both claims are the same.

Claim 26 is rejected under the double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,729,413 because the invention of both claims are the same.

Claim 27 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 of U.S. Patent No. 6,729,413.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ merely in the scope of the subject matter claimed; i.e. claim 27 of the present application are substantially included in claim 8 of US Patent No. 6,729,413, but omit the features non-critical to patentability, for example, a pair of helical spring.

Art Unit: 3721

Further, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are made broader than the specifics of the claims of the Patent as set forth above.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the receiving member adjacent the cavity since the specification discloses such feature.

Claim 29 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,729,413.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ merely in the scope of the subject matter claimed; i.e. claim 29 of the present application are substantially included in claim 9 of US Patent No. 6,729,413, but omit the features non-critical to patentability, for example, a receiving member adjacent said cavity.

Further, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are made broader than the specifics of the claims of the Patent as set forth above.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the receiving member adjacent the cavity since the specification discloses such feature.

Claim 30 is rejected under the double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,729,413 because the inventions of both claims are the same.

Art Unit: 3721

Claim 31 is rejected under the double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,729,413 because the inventions of both claims are the same.

Claim 32 is rejected under the double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,729,413 because the inventions of both claims are the same.

Claim 33 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15 of U.S. Patent No. 6,729,413.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ merely in the scope of the subject matter claimed; i.e. claim 33 of the present application are substantially included in claim 15 of US Patent No. 6,729,413, but omit the features non-critical to patentability, for example, a pair of helical spring.

Further, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are made broader than the specifics of the claims of the Patent as set forth above.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a pair of helical spring since the specification discloses such feature.

Claim 35 is rejected under the double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,729,413 because the inventions of both claims are the same.

Claim 36 is rejected under the double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,729,413 because the inventions of both claims are the same.

Claim 38 is rejected under the double patenting as being unpatentable over claim 22 of U.S. Patent No. 6,729,413 because the inventions of both claims are the same.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23-25, 27-31, 33, 34 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Habedank et al. (US 6,223,835).

With regard to claim 23, Habedank et al. discloses a mechanism and a power tool comprising: a frame (2), a cavity (void section housing spring, 39, 41 and void section between rails 36, 37) in the frame; a member (rails 36,37) for receiving a member (54, 55 channels) on the battery pack (50); a biasing member (38 spring) in the cavity extending from end wall, which ejects the battery pack; and a mechanism (41, interior of cap 39) for retaining the biasing member.

With regard to claim 24, Habedank et al. shows a pair of opposing wall (wall housing the rails 36, 37) and adjoining wall (area housing the front region of 16).

With regard to claim 25, Habedank et al. shows a receiving member (8, 9) including a pair of rails (36, 37) on each side walls; and opposing one another.

With regard to claims 27, Habedank et al. shows a helical spring (38).

With regard to claim 28, Habedank et al. shows biasing member (38) extending from the end wall as shown in Figure 7.

With regard to claim 29, Habedank et al. discloses a power tool comprising: a housing (3), a motor (M), an output (7) coupled with the motor; an activation member (5), a battery pack

Art Unit: 3721

(50), a mechanism on the housing (see figs. 3, and 5) for receiving the battery pack; a frame (2), a cavity (void section housing the spring, 39, 41 and void section between rails 36, 37), a member (rails 36,37) for receiving a member (54, 55 channels) to couple the battery pack (50) with the housing, a biasing member (38, 39) and a mechanism (41) for retaining the biasing member in the cavity (void section housing spring, 39, 41).

With regard to claim 30, Habedank et al. shows a pair of opposing wall (wall housing the rails 36, 37) and adjoining wall (area housing front region of 16).

With regard to claim 31, Habedank et al. shows receiving member (8, 9) including a pair of rails (36, 37) on each side walls; and opposing one another.

With regard to claim 33, Habedank et al. shows a helical spring (38).

With regard to claim 34, Habedank et al. shows biasing member (38) extending from the end wall as shown in Figure 7.

With regard to claim 37, Habedank et al. shows the biasing member (38) inherently, partially ejects the battery pack.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26, 32, 35, 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Habedank et al.



Art Unit: 3721

With regard to claims 26, 32, 35 and 38, Habedank et al. does not expressly disclose mating rails on the battery pack. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide mating rails on the battery pack since such feature is critical for suspending the battery pack on the tool.

With regard to claim 36, Habedank et al. does not expressly disclose battery pack rails including an upper portion, lower portion and a channel between the upper and lower portions.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide such features on the battery pack since such feature is critical for suspending the battery pack on the tool.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is (571) 272-4457. The examiner can normally be reached on M-F 6:00AM-2:30PM.

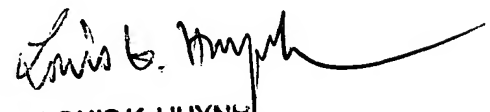
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NC

June 7, 2005.

  
LOUIS K. HUYNH  
PRIMARY EXAMINER